

### **REMARKS**

This Application has been carefully reviewed in light of the Final Office Action mailed May 21, 2003 (the "Office Action"). The Detailed Action portion of the Office Action rejects Claims 1-5, 8-11, 13-15 and 17-20. Applicants respectfully request reconsideration and favorable action in this case.

### **Office Action Discrepancy**

The Office Action Summary indicates that Claims 1-20 are rejected. However, as indicated above, the Detailed Action portion of the Office Action rejects Claims 1-5, 8-11, 13-15 and 17-20. Claims 6-7, 12 and 16 are not discussed in the Detailed Action portion. However, previous communications from the Examiner have indicated that Claims 6-7 and 12 would be allowable if written in independent form and that Claim 16 is allowable. *See, e.g.,* Advisory Action mailed July 16, 2002. Applicants respectfully request clarification that Claims 6-7 and 12 would be allowable if written in independent form to include all the limitations of the base claim and any intervening claims and that Claim 16 is allowable.

### **IDS**

An Information Disclosure Statement (the "IDS") was filed on August 7, 2002 and retransmitted to the PTO in the Request for Continued Examination filed on August 22, 2002 (the "RCE"). The Examiner has not indicated that the references disclosed in the IDS were considered. Applicants called this issue to the attention of the Examiner in Applicants' previous Response to Office Action dated February 24, 2003. Thus, Applicants again request confirmation that the references in the IDS filed on August 7, 2002 and retransmitted in the RCE have been considered by the Examiner.

### **Consideration of Applicants Arguments**

Applicants respectfully request the Examiner to consider Applicants' arguments with respect to each of the claims specifically discussed herein, including the dependent claims. Some of Applicants' previously stated reasons why particular dependent claims are patentable over the cited art have not been addressed by the Examiner in previous communications. For example, in both the RCE and Applicants' previous Response to Office Action dated

February 24, 2003, Applicants specifically set forth reasons why dependent Claims 5 and 8 are patentable over the cited art beyond the contention that such claims depend from allowable independent claims. However, in both the previous Office Action mailed November 22, 2002 and in the Office Action mailed May 21, 2003, the Examiner simply repeated the same rejections for such dependent claims without any substantive response to, or evidence of consideration of, the reasons for patentability of such claims set forth by Applicants. In this Response to Final Office Action, Applicants specifically set forth reasons why dependent Claims 5, 8 and 17-20 are patentable over the cited art in addition to simply depending from allowable independent claims. Applicants respectfully request careful consideration of the Examiner of such reasons for such dependent claims, in addition to careful consideration of the reasons stated why the independent claims are patentable over the cited art.

**Rejections Under 35 U.S.C. 103 - Kelliher/Eager**

The Examiner rejects Claims 1-4 and 17-20 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 5,857,194 to Kelliher et al. ("*Kelliher*") in view of U.S. Patent No. 5,960,200 to Eager et al. ("*Eager*"). Applicants respectfully traverse these rejections for the reasons discussed below.

**1. Claim Limitations Not Met**

Claim 1 recites "identifying incidents of applications of the legacy computer system that output data." The Examiner suggests that *Eager* discloses this element. *See* Office Action, pages 2 and 6. Applicants respectfully disagree. The Examiner states "[i]n several portions of *Eager*, specifically in column 26, lines 24-28, *Eager* cites execution rules on the source code that produces outputs of which are data access commands and data definition structures. In column 27, he describes outputs to spawn from the data definition, data access commands. He further claims 18 'obtaining the identified outputs from the legacy applications'." *See* Office Action, page 6. Applicants respectfully submit that the Examiner has merely performed a keyword search in *Eager* for words found in Applicants' claims and used such search results to reject the claims. The keywords are taken out of context and do not disclose, teach or suggest the claimed aspects of the present invention. For example, one

portion of *Eager* specifically cited by the Examiner in the quote above states "[i]n summary, executing the transformation rules on the source code produces two separate outputs: the transformed source code in a meta language, which is constituted of procedural source code and data definition structures, and a set of data access command." *See Eager*, col. 26, lines 23-27. Thus, *Eager* discloses executing transformation rules on source code to produce separate outputs. Transformation rules are programmed in and executed to transform a source language construct "to its equivalent construct in the meta language." *See id.*, col. 25, lines 54-61. Therefore, rules are programmed to produce an output of transformed source code. Such rules are not part of a legacy application. There is no disclosure in this cited portion of *Eager* of identifying incidents in a legacy application that output data.

Moreover, in discussing this execution of transformation rules on the source code, *Eager* never discusses identifying incidents that output data. *Eager* states that the execution of these transformation rules on the source code produce an output of source code transformed in a meta language and data access commands. However, producing an output of code transformed in a meta language and data access commands does not constitute disclosure of identifying incidents that output data.

As indicated above, the Examiner also cites Claim 18 of *Eager* as disclosing the above-discussed element of Applicants' Claim 1. The cited portion of Claim 18 of *Eager* discloses "obtaining the identified outputs from the legacy applications from a list of action items." *See Eager*, col. 34, lines 26-27. The mere disclosure of identified outputs from legacy applications does not support identifying incidents that output data. This cited portion of *Eager* discloses identified outputs, while Applicants' Claim 1 recites identifying incidents that output data. There is a significant grammatical difference between "identified outputs" and "identifying incidents that output data." Using the disclosure of "identified outputs" as support for disclosure of "identifying incidents that output data" of Claim 1 improperly ignores particular words of this element. *See In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art").

Applicants note the Examiner states that "Applicants claim is being interpreted in its broadest state." *See* Office Action, page 6. Applicants appreciate a broad interpretation of the claims. However, interpreting the claims broadly does not mean that the mere disclosure of some words of Applicants' claims in a reference provides support for a rejection of the claims based on such reference. As discussed above, in using *Eager* to support his rejection of Claim 1, the Examiner does not consider all words of the particular limitation that he contends *Eager* discloses and thus improperly ignores particular words that give meaning to the claim.

Therefore, for at least these reasons, Applicants respectfully submit that Claim 1 is patentable over the cited art and request that the rejection to Claim 1 be withdrawn.

Claims 2-4 and 17-18 each depend, either directly or indirectly, from Claim 1. Therefore, Applicants respectfully submit that Claims 2-4 and 17-18 are patentable over the cited art, for example, for the same reasons discussed above with regard to Claim 1 and request that the rejections to Claims 2-4 and 17-18 be withdrawn.

In addition, Claim 17 recites wherein identifying incidents of applications of the legacy computer system comprises identifying incidents of applications of the legacy computer system "within the source code" of the applications. Thus, since Claim 17 depends from Claim 1, Claim 17 includes identifying incidents within the source code that output data. As discussed above, *Eager* does not disclose, teach or suggest identifying incidents that output data. Moreover, *Eager* does not disclose, teach or suggest identifying incidents within the source code that output data. The Examiner cites *Eager* col. 26, lines 2-27 and col. 27, lines 12-20 as support for his rejection of Claim 17. *See* Office Action, page 3. These cited portions of *Eager* deal with executing transformation rules on source code to produce outputs. For example, *Eager* states "[e]xecuting the transformation rules on the meta language source code produces output files containing the transformed code in the target language: procedural source code files, data definition structure files, and final data access command files." *See Eager*, col. 27, lines 16-20. There is nothing identified within the source code that outputs data. Therefore, *Eager* does not disclose, teach or suggest identifying incidents within the source code that output data. Again, the mere disclosure of

keywords (in this case "source code" and "outputs") does not provide support for rejection of this particular element of Claim 17.

Moreover, Claim 18 recites wherein the incidents comprise "report commands." The Examiner cites col. 12, lines 5-10 and 35-44 of *Eager* as disclosing this element. Such portions of *Eager* state "the business process layer 120, functionality layer 130, and data access layer 140 further link a printer 135 which can be used to provide a permanent record of application log files, reports, source code, or process objects and flows according to the present invention." See *Eager*, col. 12, lines 6-11. In addition, the cited portions state:

[T]he state router 122 is simply a switch that differentiates between request identifiers and takes appropriate action in the form of a call to a function of the functionality layer 130. Screen information is used to keep track of the current state of the application. Input buffers are used to carry information from the presentation layer 110 to the business process layer 120 and output buffers are used to carry information from the business process layer 120 to the presentation layer 110.

See *Eager*, col. 12, lines 34-42. These cited portions of *Eager* do not disclose, teach or suggest identifying report commands of a legacy computer system that output data. Again, it appears that the Examiner has performed a keyword search for the word "report" in *Eager* and cited the results in support of the rejection of Claim 18. The mere disclosure of a printer for providing a record of reports or source code does not constitute disclosure of identifying report commands within the source code that output data.

## **2. No Proper Basis for Modification**

In response to Applicants' contention in the Response to Office Action dated February 24, 2003 that the combination of *Kelliher* with *Eager* was improper, the Examiner states:

With regard to Applicants assertion for no motivation to combine *Kelliher* and *Eager*, Examiner disagrees. Both *Kelliher* and *Eager* and [sic] very much analogous art, dealing with Legacy system either through reengineering, transitioning, rearchitecting, or support for legacy system as disclosed in *Eager* and transmission and mapping of Legacy data in *Kelliher*. Applicants disclosure deals with Modeling a Legacy system, which is very similar to what both *Kelliher* and *Eager* have shown. In all three applications definitions and specifications have to be declared and met in order for the system to proper efficiently. Therefore visually or graphically representing fields or incidents

during this process in order to efficiently design or improve a system is a general solution and a reason for one to be motivated to employ any one of the techniques as discussed or combined by the prior art.

See Office Action, pages 6-7. Applicants first note that the subject of Applicants' disclosure, modeling a legacy system, is irrelevant to the question of the whether a combination of prior art references used to reject Applicants' claims is proper.

Broad conclusory statements by the Examiner regarding the teaching of multiple references standing alone are not "evidence." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Civ. 1999). Instead, the Examiner must explain the "specific understanding or principle within the knowledge of the skilled artisan that would motivate . . . the combination." *Id.* Where the Examiner does not explain the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate one with no knowledge of the applicant's claimed invention to make the combination, the Federal Circuit infers that the Examiner selected the references with the assistance of hindsight. *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (*emphasis added*).

While *Kelliher* and *Eager* both broadly deal with legacy computer systems, there is no support in the prior art to combine the cited teachings of *Kelliher* and *Eager*. *Eager* is directed to automatic translation of legacy applications into new applications on a multi-tiered client/server architecture. See *Eager*, col. 2, lines 44-47. This is accomplished by converting source program components written in source languages to components in an intermediate language and then to target program components in target languages. See *id.*, col. 2, lines 47-55. However, *Kelliher* is directed towards a system that works on an existing legacy system, such as a Physician's Office Management System (POMS), and automatically determines the data format of a storage device of the existing legacy system, extracts data required by a service company, such as an insurance company, and transmits the data in one of several predetermined industry standard formats. See *Kelliher*, col. 2, lines 10-16. There is no explicit or implicit reference in *Kelliher* to transitioning or converting a legacy application or its source language to a target client/server architecture or target language. Moreover, there is no implicit or explicit reference in *Eager* to extracting data from a storage device of an existing legacy system for transition in an industry standard format. Since

*Kelliher* is merely an extraction process for data in a legacy system and does not in any way relate to transitioning from one business enterprise to a distributed infrastructure, there is nothing to motivate one of ordinary skill in the art to make the proposed combination.

Moreover, as discussed above, in rejecting Applicants' claims the Examiner has combined portions of *Eager* which execute transformation rules on source code to produce outputs that include transformed source code, data definition structures and a set of data access commands with cited portions of *Kelliher*. However, nothing in *Kelliher* even remotely relates to executing rules on source code or even doing anything with source code of a legacy system. As also discussed above, the Examiner combines "obtaining the identified outputs from the legacy applications from a list of action items" of *Eager* with portions of *Kelliher* in rejecting Applicants' claims. Such outputs are identified in *Eager* as "measurable outcomes that will clearly indicate the achievement of the associated objective," where objectives are the "specific goals" of the "corporate vision." See *Eager*, col. 6, lines 7-16. Again, nothing in *Kelliher* even remotely relates to identifying measurable outcomes indicating achievement of associated goals of a corporate vision.

As stated above, the Examiner states that with regard to these references, "definitions and specifications have to be declared and met in order for the system to proper efficiently." See Office Action, pages 6-7. Applicants are unclear as to the exact meaning or relevance of this statement, but the mere fact that in the cited references definitions and specifications must be declared and met for efficient system operation does not provide the required motivation for one skilled in the art to combine the references. The Examiner additionally states "[t]herefore visually or graphically representing fields or incidents during this process in order to efficiently design or improve a system is a general solution and a reason for one to be motivated to employ any one of the techniques as discussed or combined by the prior art." See Office Action, page 7. As discussed above, broad conclusory statements by the Examiner regarding the teaching of multiple reference standing alone are not evidence. See *Dembiczak* at 999. These statements by the Examiner do not provide the specific understanding or principle within the knowledge of a skilled artisan that would motivate one skilled in the art to combine the teachings of *Eager* with *Kelliher*, as is required by the Federal Circuit as indicated above. See, e.g., *Rouffet* at 1358.

Therefore, for at least these reasons, Applicants respectfully submit that the *Kelliher-Eager* combination is improper and thus does not render Claims 1-4 and 17-20 unpatentable over the cited art.

**Rejections Under 35 U.S.C. 103 - Kelliher/Eager/Meltzer**

The Examiner rejects Claims 5, 8-11, and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over *Kelliher* and *Eager* as applied in Claim 1 and further in view of U.S. Patent No. 6,125,391 issued to Meltzer et al. ("Meltzer"). Applicants respectfully traverse these rejections and all findings therein for at least the reasons discussed below.

The prior art as cited by the Examiner does not disclose, teach or suggest each element of Claims 5, 8 or 9. Claims 5, 8 and 9 each depend from Claim 1. The Examiner implies that *Kelliher* in view of *Eager* discloses all elements of Claims 5, 8 and 9 that are included in Claim 1. However, as discussed above with regard to Claim 1, the proposed combination of *Kelliher* and *Eager* is improper. Furthermore, as discussed above even if such combination is considered proper, the *Kelliher-Eager* combination still does not disclose, teach or suggest "identifying incidents of applications of the legacy computer system that output data."

Moreover, Claim 5 includes "plural nodes having associated arcs, each node associated with an output incident." The Examiner states that *Meltzer* discloses "plural nodes having arcs in a legacy system." See Office Action, page 4. The Examiner cites column 2, lines 55-56 of *Meltzer* which discloses a "node in the commerce network [establishing] an interface for transactions. . . ." However, the Examiner has not cited any support in *Meltzer* for plural nodes having **associated arcs**, each node **associated with an output incident**, nor does *Meltzer* disclose, teach or suggest these elements.

Furthermore, Claim 8 includes "associating the incidents with an Extensible Markup Language schema; and creating a specification to modify the legacy computer system applications to provide output in Extensible Markup Language format." In rejecting Claim 8, the Examiner merely states that *Meltzer* discloses these elements without citing any support in *Meltzer* for this assertion. See Office Action, page 4. Applicants respectfully request



allowance of Claim 8, because *Meltzer* does not disclose, teach or suggest "associating the incidents with an Extensible Markup Language schema; and creating a specification to modify the legacy computer system applications to provide output in Extensible Markup Language format."

Therefore, for at least the reasons stated above, Applicants respectfully request that the rejections of Claims 5, 8 and 9 be withdrawn.

The prior art as cited by the Examiner does not disclose, teach or suggest each element of Claim 10. Claim 10 includes "a modeling engine interfaced with the legacy computer system, the modeling engine operable to analyze an application loaded on the legacy computer system to identify incidents within the application that output data from the legacy computer system." The Examiner implies that the proposed combination of *Kelliher* and *Eager* discloses all the limitations of Claim 10 as applied in Claim 1 except for the disclosure of a modeling engine. *See* Office Action, pages 4-5. However, as discussed above with regard to Claim 1, the proposed combination of *Kelliher* and *Eager* is improper. Furthermore, as discussed above even if such combination is considered proper, the *Kelliher-Eager* combination still does not disclose, teach or suggest a modeling engine operable to identify incidents within an application loaded on a legacy computer system that output data.

Furthermore, the Examiner states that *Meltzer* discloses a "similar apparatus" to the modeling engine of Claim 10. The Examiner cites an "Element generator and attribute Generator" of Figure 5 of *Meltzer* as support. *See* Office Action, page 5. Applicants respectfully disagree with the Examiner's assertion. *Meltzer* discloses "[a]n element event generator 504 [that] is a specialized ESIS listener which is also an XML event generator." *See Meltzer*, col. 27, lines 12-13. *Meltzer* discloses an "attribute event generator 505 [that] supplies the attribute event objects to attribute listeners 505A." *See Meltzer*, col. 27, 58-60. These elements are not modeling engines. Thus, the Examiner has failed to cite any teaching in *Meltzer* or other art of a modeling engine.

Therefore, for at least the reasons stated above, Applicants respectfully request that the rejection to Claim 10 be withdrawn.

Claims 11, 13-15 and 19-20 each depend, either directly or indirectly, from independent Claim 10. Therefore, Applicants respectfully submit that Claims 11, 13-15 and 19-20 are patentable over the cited art, for example, for the same reasons discussed above with regard to Claim 10 and request that the rejections to Claims 11, 13-15 and 19-20 be withdrawn.

Moreover, Claim 19 recites "wherein the modeling engine is operable to identify the incidents within the source code of the application," and Claim 20 recites "wherein the incidents comprise report commands." As discussed above with respect to Claims 17 and 18, respectively, *Eager* does not disclose, teach or suggest identifying incidents within the source code that output data or identifying report commands within the source code that output data. Therefore, for at least these additional reasons Applicants respectfully request that the rejections to Claims 19 and 20 be withdrawn.

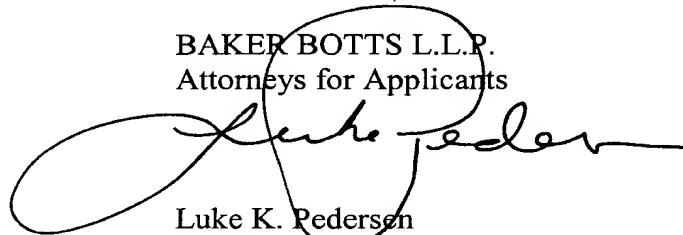
**CONCLUSION**

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicants



Luke K. Pedersen  
Reg. No. 45,003

Date: July 21, 2003

2001 Ross Avenue, Suite 600  
Dallas, TX 75201-2980  
Tel. 214.953-6655

**Correspondence Address:**

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